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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/766,277

01/19/2001

Robert K. Samson

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7590

06/09/2009

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

06/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/766,277

**Applicant(s)**

SAMSON, ROBERT K.

**Examiner**

DANIEL S. FELTEN

**Art Unit**

3696

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 78-86 and 113-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78-86 and 113-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CC)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 3/05/2009 have been fully considered but they are not persuasive. The applicant is respectfully reminded that references, in determining obviousness are not read in isolation but for what they fairly teach in combination with the prior art as a whole. It is being maintained that references also are evaluated by what they suggest to one versed in the art rather than their specific disclosure [see *In re Bozek*, 163 USPQ 545 (CCPA 1969)]. It is being maintained that the applicant's assertion that Giansante lacks "means for receiving a relative weight of importance for said two or more criteria..." and "means for determining a rating for each asset based on the normalized values and the relative weights..." or "means for ranking..." It is being maintained that there is an uncertainty from the applicant's specification as to the corresponding structure to perform the various functions the applicant maintains as not found in the Giansante reference. It is being maintained that the 35 U.S.C. set forth provided reasoning for the combination of references and the applicant's piecemeal analysis of the reference can not be used to show non-obviousness by attacking the references individually. Similar to the applicant's invention, it is maintained that Giansante in combination with Champion discloses adjusting the weights of assets in each efficient portfolio to optimize the level of industry sector and diversification in the portfolio to maintain the portfolio at a position on or near the efficient frontier and the desired risk level. It is being maintained that the adjusting of weights to optimize the level of industry sector suggest a functional equivalent of ranking and normalization claimed in the applicant's invention inasmuch as normalization seeks to reduce redundancies in data to make its use more efficient

and the maintenance of the portfolio a certain position and at a certain risk level suggests ranking (see at least Giansante, column 6, lines 7-67). Thus the the following reasons maintained above the rejections are maintained below.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 78-86 and 113-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giansante (US 6,275,814) in view of Champion et al (US 5,126,936)

**Re claim 78:** An investment guidance system for providing financial planning assistance, comprising:

--means for receiving a financial goal from a user (see column 5, lines 47-65);

--means for receiving one or more input decisions upon which the probability of achieving said financial goal is dependent, wherein one of the input decisions includes selecting an asset allocation based on investment risk (see column 5, lines 48+);

--means for determining the probability of achieving said financial goal (see fig. 4, column 4, lines 28-61);

--means for receiving an indication that said user has selected a target asset allocation investment plan in order to achieve said financial goal (see column 5, lines 48-65);

--means for receiving a request to rate a plurality of assets within a selected asset Class (see column 6, lines 36+);

--means for providing two or more criteria associated with said assets for said user to evaluate (see column 6, lines 36+);

--means for determining a normalized value for each of said two or more criteria; means for receiving a relative weight of importance for said two or more criteria based on the user's personal investment preferences (see column 6, lines 36+);

--means for determining a rating for each asset based on the normalized values and the relative weights assigned to said two or more criteria (see column 6, lines 36+)

--means for ranking plurality of said assets based on said rating (see column 6, lines 36+)

--Giansante fails to disclose means for receiving a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan; and means for executing said trade for one or more of the selected ranked assets. This is disclosed by Champion (see fig. 3, column 6, lines 13-33). It would have been obvious for Giansante to be motivated to execute trade requests, as contemplated in Champion, to allow the user to implement the asset suggestions of Giansante and to further allow the user to optimize the level of industry sector and investment style diversification in the portfolio, whereby the portfolio is

maintain the portfolio at a position on or near the efficient frontier and at the desired risk level (see Giansante, column 6, lines 36+).

**Re claim 79:** means for reallocating asset distribution in a user's portfolio based on executed trades. (see reasoning provided in claim 78)

**Re claim 80:** means for receiving additional requests to execute said trade for one of the ranked assets in order to fulfill said target asset allocation investment plan (see reasoning provided in claim 78)

**Re claim 81:** means for evaluating said target asset allocation investment plan against one or more financial goals;

--means for alerting the user if progress towards one or more financial goals deviates substantially (see reasoning provided in claim 78)

**Re claim 82:** wherein said financial goal is a retirement income (see reasoning provided in claim 78)

**Re claim 83:** wherein one of said input decisions upon which the probability of achieving said financial goal is dependent is a 401 (k) contribution rate (see reasoning provided in claim 78)

**Re claim 84:** wherein one of said input decisions upon which the probability of achieving said financial goal is dependent is a taxable savings rate (see reasoning provided in claim 78)

**Re claim 85:** wherein one of said input decisions upon which the probability of achieving said financial goal is dependent is the income required at retirement (see reasoning provided in claim 78)

**Re claim 86:** wherein one of said input decisions upon which the probability of achieving said financial goal is dependent is an anticipated retirement age (see reasoning provided in claim 78).

**Re claim 113:** wherein the means for determining the normalized value for each of said two or more criteria comprise: means for creating a distribution of the assets; and

means for computing, for each of said two or more criteria of each of the assets in the distribution, normalized values of said two or more criteria based on the relative position of the respective asset in the distribution. (see reasoning provided in claim 78).

**Re claim 114:** wherein the means for determining the rating for each asset based on the normalized values comprises:

means for multiplying each of the normalized values associated with each of the assets by the respective relative weight of importance; and

means for summing the normalized values associated with each of the assets multiplied by the respective weights to obtain the respective rating for each of the assets, the respective rating being an aggregate sum corresponding to the respective asset's associated values multiplied by the associated values' respective weights . (see reasoning provided in claim 78)

**Re claim 115:** wherein the means for means for ranking plurality of said assets based on said rating comprises:

means for ranking the assets based on the aggregate sum for each of the assets (see reasoning provided in claim 78)

**Re claim 116:** wherein the two or more criteria comprises one or more of: an R-squared value representative of a correlation between the value of an asset and the behavior of one more benchmark indices, a tax efficiency value computed as an after-tax returns for the asset divided by the pre-tax returns, an information ratio representative of the consistency with which a manager managing the assets generally beats the one or more benchmark indices, a risk factor associated with the asset, administrative fees associated with the asset and standard deviation associated with the asset . (see reasoning provided in claim 78)

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL S. FELTEN whose telephone number is (571)272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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